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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,159	06/20/2003	Joshua T. Goodman	MSFTP418US	7622
27195	7590	06/01/2009		
TUROCY & WATSON, LLP 127 Public Square 57th Floor, Key Tower CLEVELAND, OH 44114				
EXAMINER				
COULTER, KENNETH R				
ART UNIT		PAPER NUMBER		
2454				
NOTIFICATION DATE		DELIVERY MODE		
06/01/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docket1@thepatentattorneys.com  
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### Office Action Summary

**Application No.**

10/601,159

**Applicant(s)**

GOODMAN ET AL.

**Examiner**

Kenneth R. Coulter

**Art Unit**

2454

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-69 and 71-75 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-34 is/are allowed.
- 6) ☒ Claim(s) 35-69 and 71-75 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 101*

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 35 – 69, 71, and 72 are rejected under 35 USC 101 because the claimed invention, in light of the specification (for example on page 8 (paragraph 2)), encompasses non-statutory subject matter since such reads on (encompasses) software or program per se' (In re Beauregard (CAFC) 35 USPQ2d 1383) and MPEP 2106 (new EXAMINATION GUIDELINES FOR COMPUTER-RELATED INVENTIONS). Even though drafted as "A method", each of the recited elements encompass their software or program per se' equivalent (i.e., a client such as a Netscape Web Browser and/or a server such as Apache are each software devices and yet phrased as a client and a server); thus, the whole of the method encompasses pure software or program per se'; unlike "A method executing on hardware". Also, while a hardware device claim, with functional acts, may inherently encompass a corresponding method, the same does not hold in the reverse since a corresponding method is broader in scope and can encompass a scope void of any hardware. Per the program storage medium, such encompasses a carrier wave or transmission medium (carrier waves store data for the duration of transmission over a period of time and is thus storage); unlike a "hardware computer readable program storage medium".

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 35 – 69 and 71 – 75 are rejected under 35 U.S.C. 102(e) as being anticipated by Bates (U.S. Pat. No. 6,779,021).

Regarding claims 35 – 69 and 71 – 75, the rejection of claims 1 – 75 (Final rejection on 9/19/08; paragraphs 2.1 – 2.33) applies.

1. Claims 61 – 69 and 74 are rejected under 35 U.S.C. 102(e) as being anticipated by Wilson (U.S. Pat. Pub. No. 2004/0015554) (Active E-Mail Filter With Challenge-Response).

3.1 Regarding claim 61, Wilson discloses a method that facilitates periodic validation of non-spammer like activity by a user account comprising:

employing a processor executing computer executable instructions to perform the following acts:

monitoring the user account for at least one of a volume of outgoing messages, a volume of recipients in one or more outgoing messages, or a rate of outgoing messages (Abstract; paragraphs 23, 37);

requiring an owner of the user account to resolve one or more challenges after at least one of a number of outgoing messages sent from the user account exceeds a predetermined threshold **or** a number of recipients counted in one or more sent messages from the user account exceeds a predetermined threshold (Figs. 1, 2, 3, 5; paragraphs 61 – 63); and

suspending sending of subsequent outgoing messages from the user account until the one or more challenges are resolved (Abstract; Figs. 1, 2, 3, 5; paragraphs 23, 24).

3.2 Per claim 62, Wilson teaches that each recipient listed in a message counts as an individual message (Figs. 1, 2, 3, 5; paragraphs 61 – 63).

3.3 Regarding claim 63, Wilson discloses that the challenge is a computational challenge (Fig. 1; paragraphs 45, 55).

3.4 Per claim 64, Wilson teaches that the challenge is a human interactive proof (Fig. 5; paragraph 77).

3.5 Per claims 65 – 69 and 74, the rejection of claims 61 – 65 (paragraphs 3.1 – 3.4 above) applies fully.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth R. Coulter whose telephone number is 571 272-3879. The examiner can normally be reached on M - F, 7:30 am - 4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Flynn can be reached on 571 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kenneth R Coulter/  
Primary Examiner, Art Unit 2454

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/KRC/